

## **REMARKS**

In the Office Action mailed on November 16, 2004, claims 1-6, 8-11, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of the disclosures of the U.S. Patent of Eby No. 3,721,374 and the U.S. Patent of Lund No. 5,130,906. It is submitted that neither of these prior art references disclose or suggest the subject matter of the invention recited in the rejected claims, and therefore the references fail to provide sufficient information to the ordinary skilled artisan to render the subject matter of the rejected claims obvious. Claims 1-6, 8-11, and 15 are therefore allowable over the prior art.

In the rejections of the claims, the claim language "connectable" was basically ignored. It was contended that reciting in a claim that an element is "capable of" performing a function is not a positive limitation but only requires the ability to perform the function. Therefore, the phrase "being connectable" appearing in the claims was ignored.

It is submitted that the phrase "capable of" is entirely different from the phrase "being connectable". An element that is connectable to another element recites a positive limitation. The two elements are positively recited as being matched to each other so that they are connectable to each other. This language has no relation to the phrase "capable of". It is therefore submitted that the rejections based on this argument are made in error.

Furthermore, to make clear that the claim phrase "is connectable to" and the claim phrase "being connectable to" recites a positive limitation, the claims of the application have been amended to include -- means plus function -- language where, for

example, the mounting bracket of the invention is no longer recited as being connectable to another element, but is recited as having means for connecting the mounting bracket to the other element. Under 35 U.S.C. §112, sixth paragraph, this language of the claims can not be ignored.

Of the claims rejected as being obvious in view of the Eby and Lund references, claims 1 and 9 are independent claims. These claims recite structural features of the invention that are not disclosed or suggested in the Eby or Lund references, and are actually taught away from by these references. Without there being any disclosure or suggestion of the claimed subject matter in the two references, the claims are not obvious and are allowable over the prior art.

More specifically, claim 1 includes a recitation of the mounting bracket having means for connecting the mounting bracket to the light bar and to the vehicle to hold the support and the light assemblies on the support in positions extending across either the front or rear facing windows adjacent the top edge of the windows "and not above the top surface of the vehicle". This quoted feature of claim 1 is clearly not disclosed or suggested by the lamp mount of the Eby reference. The lamp mount is specifically designed to extend across the top surface of the vehicle. There is no suggestion in the reference of the mounting bracket recited in claim 1 that does not extend above the top surface of the vehicle.

The mounting bracket of the invention recited in claim 1 is also not disclosed or suggested in the Lund reference. The Lund reference makes no disclosure of such a mounting bracket. Instead, the Lund reference discloses a rigid visor 1 constructed of materials such as metals or composites and preferably constructed of molded fiber

glass material (Lund column 2, lines 40-44). The visor is attached to the vehicle roof 30 by mounting holes that are located around the visor perimeter. The visor trailing edge 5 typically resides above the vehicle roof 60 (Lund column 2, lines 44-48).

Thus, the Lund reference specifically teaches attaching the visor 1 to the roof of the vehicle. This attachment positioning is shown in Figure 1 of the reference where the visor 1, and in particular the trailing edge of the visor, is positioned on top of the vehicle roof. This is in direct contrast to the subject matter of claim 1 which specifically states that the mounting brackets position the support and the plurality of light assemblies adjacent the window top edge "and not above the top surface of the vehicle". Because both the Eby and Lund references specifically teach away from the structure of the light bar of the invention recited in claim 1, the references do not make obvious that subject matter and claim 1 and its dependent claims 2-6 and 8 are allowable over the prior art of record.

With regard to the rejection of claim 9 in view of the Eby and Lund references, it is submitted that there is no motivation for combining these references to arrive at the subject matter of claim 9, and that the rejection of the claim is based entirely on hindsight of the present invention.

The Eby reference discloses a mounting bracket assembly for supporting an emergency light on the roof of an automobile. The references specifically sets forth that the main object of the invention is to provide a mounting bracket device adapted to be detachably connected to the roof of an automobile (Eby column 1, lines 6-8). The reference further sets forth that a further object of the invention is to provide a mounting bracket assembly for supporting emergency lamps on the roof of an automobile (Eby

column 1, lines 14-17). Thus, the Eby reference is specifically directed for supporting lamps on an automobile roof. There is no suggestion of a support that holds lamps extending across the vehicle windows as required by claim 9. This suggestion can only be found in the applicant's disclosure.

The Lund reference, as explained earlier, discloses a visor 1 that is attached to a vehicle roof (Lund column 2, lines 44-45). The visor trailing edge resides above the vehicle roof (Lund column 2, lines 47-48). Thus, the Lund reference also fails to disclose or suggest a light support that is held extending across the vehicle window as recited in claim 9.

Because neither of the applied references remotely suggest the subject matter of the invention recited in claim 9, and actually teach away from that subject matter, it is submitted that the combination of references relied on in rejecting claim 9 is made in hindsight of the present invention, and therefore is made in error. Claim 9 is therefore allowable over the prior art. Claims 10, 11, and 15 all depend from claim 9, and therefore are allowable over the prior art of record.

Claims 7, 12-14, and 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of the disclosures of the Eby and Lund references, and further in view of the disclosure of the U.S. Patent of Carr No. 4,928,216. It is submitted that the rejection of the claims in view of these references is based on a misinterpretation of what the Carr reference discloses, and therefore the rejections are made in error.

Claims 7, 12-14, and 16-20 are therefore allowable over the prior art.

In the rejection of the claims, it is contended that the Carr reference teaches a plurality of light assemblies, with each light assembly being mounted in a case of a

plurality of cases for adjusting movement of the light assembly. Figure 2 of the Carr reference is referred to for support of this contention.

Claim 7 of the rejected claims depends from claim 1 and claims 12-14 of the rejected claims depend from claim 9. It is respectfully submitted that the Carr reference does not overcome the shortcomings of the Eby and Lund references set forth above with regard to the rejections of claims 1 and 9. For this reason alone, it is submitted that claims 7, 12-14, and 16-20 are allowable over the prior art.

Of the rejected claims, claim 16 is an independent claim. Among other novel features of the invention recited in claim 16, the claim requires a plurality of light assemblies with each light assembly being mounted in a case of a plurality of cases for adjusting movement of the light assembly relative to the case. Thus, claim 16 specifically recites that the light assembly in each case is adjustable relative to its case. This subject matter of the invention is not identified in any of the three prior art references relied on in rejecting the claim. Instead, the rejection refers to Figure 2 of the Carr reference, which depicts a light bar 12 having a plurality of lights 11 thereon, where the light bar 12 and lights 11 are movable relative to a pair of brackets 13a, 13b. The reference does not remotely suggest light assemblies that are movable within their casings as required by claim 16. In view of this shortcoming of the Carr reference, it is submitted that the three prior art references relied on in rejecting the claims fail to provide sufficient information to render the claimed subject matter obvious, and therefore claims 7, 12-14, and 16-20 are allowable over the prior art of record.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,

**Thompson Coburn LLP**

By: Joseph M. Rolnicki  
Joseph M. Rolnicki  
Reg. No. 32,653  
One US Bank Plaza  
St. Louis, MO 63101-1693  
(314) 552-6286